

REMARKS

Upon entry of this amendment, claims 1 and 3-21 will be pending. Claims 1 and 3-20 stand rejected.

Claims 1 and 19 are amended and claim 21 is added. Support for the amendments and newly added claim can be found, *inter alia*, at paragraphs [0065] and [0070] of the specification and in Figures 5-11.¹ No new matter is introduced.

Applicant has reviewed the Office action, including the Examiner's remarks and the references cited therein. Applicant submits that the following remarks are fully responsive to the Office action, and that all pending claims are patentable over the cited references.

Rejections Under 35 U.S.C. § 103

Claims 19 and 20

The Examiner rejects claims 19 and 20 under 35 U.S.C. § 103 as obvious over United States patent no. 6,001,093 ("Swanson") in view of United States patent no. 5,913,854 ("Maguire"). Applicant respectfully disagrees.

Though the prior art references need not teach or suggest each and every limitation of a claim for that claim to be obvious, Applicant contends that the differences between the rejected claims and the references cited are sufficiently great so as to render the claimed invention non-obvious to one of ordinary skill in the art at the time the invention was made. MPEP § 2141 ("[T]he focus when making a determination of obviousness should be on what a person of ordinary skill in the pertinent art would have known at the time of the invention, and *on what such a person would have reasonably expected to have been able to do in view of that knowledge.*") (emphasis added). As discussed in greater detail below, Applicant contends one of ordinary skill in the art would not have learned the claimed invention from the asserted references because the asserted references do not teach or suggest each and every element of the claimed invention.

¹ Paragraph references are to the application as published. United States patent application publication no. 2005/0004440 (Jan. 6, 2005).

As amended, claim 19 recites that “the at least one manifold includes at least one manifold inlet port in fluid communication with an ablating fluid outlet port, the ablating fluid outlet port having a larger cross-sectional area than the at least one manifold inlet port.” That is, as shown in Figure 7, the cross-section of the manifold expands from the inside of the catheter (*i.e.*, the point at which the manifold connects to the fluid lumen) to the outside of the catheter (*i.e.*, the point at which the manifold breaches the outer surface of the catheter wall). This configuration advantageously “helps to reduce the likelihood of saline stagnation areas within the outlet port 78.” Specification ¶ [0068].

The Examiner admits that Swanson neither teaches nor suggests the claimed manifold. See Office action, p.2 (“Swanson et al fail to disclose the particular manifold along the partial curve . . .”). The Examiner relies upon Maguire for this aspect of the invention. *Id.* Maguire, however, appears to teach only openings of uniform cross-section, and does not appear to teach or suggest the claimed manifolds of varying cross-sectional area. See, *e.g.*, opening 49 in Figure 7A.

Applicant respectfully submits that, because neither Swanson nor Maguire teaches the claimed manifold configuration, the combination of Swanson and Maguire does not render claim 19 *prima facie* obvious. It follows that claim 20 is also non-obvious. See MPEP § 2143.03 (“If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious.”) (citing *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988)). Reconsideration and withdrawal of the rejection of claims 19 and 20 is respectfully requested.

Claims 1, 3-6, 10, and 11

The Examiner rejects claims 1, 3-6, 10, and 11 under 35 U.S.C. § 103 as obvious over Swanson in view of Maguire and United States patent no. 3,773,034 (“Burns”). Applicant respectfully disagrees.

Like amended claim 19, amended claim 1 recites that “the at least one manifold includes at least one manifold inlet port in fluid communication with an ablating fluid outlet port, the ablating fluid outlet port having a larger cross-sectional area than the at least one manifold inlet port . . .” As discussed above, neither Swanson nor Maguire

teaches or suggests this aspect of the claimed invention. Burns also fails to teach or suggest this aspect of the present invention.

For at least the foregoing reasons, Applicant respectfully submits that claim 1, and all claims depending therefrom, are substantially different from, and therefore non-obvious over, the combination of Swanson, Maguire, and Burns. Reconsideration and withdrawal of the rejection of claims 1, 3-6, 10, and 11 is respectfully requested.

Claims 7-9

The Examiner rejects claims 7-9 under 35 U.S.C. § 103 as obvious over Swanson, Maguire, and Burns in view of United States patent no. 6,600,956 ("Maschino"). Applicant respectfully disagrees.

Claims 7-9 depend from claim 1. The shortcomings of the combination of Swanson, Maguire, and Burns with respect to claim 1 are discussed at length above and are not cured by the addition of Maschino. Accordingly, Applicant submits that the claimed invention is substantially different from, and therefore non-obvious over, the asserted references. Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 7-9 under 35 U.S.C. § 103.

Claims 12-18

The Examiner rejects claims 12-18 under 35 U.S.C. § 103 as obvious over Swanson, Maguire, and Burns in view of United States patent no. 5,499,981 ("Kordis"). Applicant respectfully disagrees.

Claims 12-18 depend from claim 1. The shortcomings of the combination of Swanson, Maguire, and Burns with respect to claim 1 are discussed at length above and are not cured by the addition of Kordis. Applicant therefore respectfully submits that the claimed invention is substantially different from, and therefore non-obvious over, the asserted references. Applicant respectfully requests reconsideration and withdrawal of the rejections of claims 12-18 under 35 U.S.C. § 103.

CONCLUSION

In view of the foregoing remarks, Applicant respectfully submits that the application is in condition for allowance, and requests that all rejections be withdrawn, that all pending claims be allowed, and that the application be passed to issue. If, for any reason, the Examiner finds the application to be in other than condition for allowance, the Examiner is invited to contact the undersigned in an effort to resolve any matter still outstanding before issuing another action.

Applicant has provided for a one month extension of time concurrently herewith. Should any further extension of time be deemed necessary for this paper to be considered timely, Applicant hereby petitions therefor under 37 C.F.R. § 1.136.

Authorization is hereby granted to charge any fees due with the filing of this document, including fees for any further extensions of time deemed necessary, to Deposit Account No. 50-1129 with reference to Attorney Docket No. 0B-044900US/82410-0195.

Respectfully submitted,

WILEY REIN LLP

Date: March 19, 2010

By: /Scott A. Felder #47558/
Scott A. Felder
Registration No. 47,558

WILEY REIN LLP
Attn: Patent Administration
1776 K Street, N.W.
Washington, D.C. 20006
Telephone: 202.719.7000
Facsimile: 202.719.7049